

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TENNESSEE
AT KNOXVILLE**

UNIVERSITY OF TENNESSEE RESEARCH
FOUNDATION,

Plaintiff,

v.

CAELUM BIOSCIENCES, INC. AND THE
TRUSTEES OF COLUMBIA UNIVERSITY IN
THE CITY OF NEW YORK,

Defendants.

Case No. 3:19-CV-00508 (CEA) (JEM)

**DEFENDANTS CAELUM BIOSCIENCES, INC. AND THE TRUSTEES OF COLUMBIA
UNIVERSITY IN THE CITY OF NEW YORK'S MOTION TO COMPEL
MODIFICATION OF PLAINTIFF'S CONFIDENTIALITY DESIGNATIONS,
COMPEL THE DEPOSITION OF DR. ALAN SOLOMON,
AND MODIFY THE SCHEDULING ORDER**

Pursuant to Federal Rule of Civil Procedure 37(a)(3)(B)(iii-iv) and Local Rules 7.1 and 37.2, Defendants Caelum Biosciences, Inc. (“Caelum”) and The Trustees of Columbia University in the City of New York (“Columbia”) respectfully request that the Court enter an Order compelling Plaintiff University of Tennessee Research Foundation (“UTRF”) to modify the confidentiality designations for documents bates labeled UTRF_015284, UTRF_116819, and UTRF116825, which UTRF cites in its Supplemental Response to Caelum’s Interrogatory No. 1, from Technical AEO to Confidential. Defendants further request that the Court compel UTRF to amend paragraphs 16-21 of its Supplemental Response to Interrogatory No. 1 to either (1) cite to an alternative source for the CHO cell clone sequences and, accordingly, modify the Supplemental Response to remove the associated redactions; or (2) delete paragraphs 16-21 from UTRF’s list of purported trade secrets in response to Caelum’s Interrogatory No. 1. Defendants further request that the Court compel the deposition of Dr. Alan Solomon within 30 days and, finally, extend the Scheduling Order deadlines by 60 days.

Caelum’s Interrogatory No. 1 asks UTRF to “Identify in list form and Describe with particularity all trade secrets [UTRF] contend[s] Caelum misappropriated.” On July 13, 2022, Judge McCook ordered UTRF to serve an amended response to Interrogatory No. 1 properly listing the specific trade secrets that Caelum allegedly misappropriated. (*See* ECF No. 179.) Although UTRF complied, it designated its Supplemental Response as Technical AEO under the Protective Order, thereby triggering the patent prosecution bar. UTRF also cited to various documents similarly designated Technical AEO, effectively prohibiting Defendants, certain of their lawyers, and any consulting experts from viewing the list and supporting documents. Upon request from Defendants that UTRF modify the designation to allow Defendants full access to the list of purported trade secrets in order to have a reasonable opportunity to defend themselves, UTRF

served a Confidential version of the Supplemental Response which merely redacted all the Technical AEO information and declined to de-designate any Technical AEO cited documents. UTRF's designations are improper and unfair as they severely prejudice Defendants' ability to prepare and understand the claims against them.

Meanwhile, counsel for UTRF, The University of Tennessee ("UT"), Dr. Alan Solomon, Dr. Jonathan Wall, Dr. Patrick Reynolds, and Ms. Deborah Smith, has refused to produce Dr. Solomon for deposition. The only grounds for objection provided to Defendants have been Dr. Solomon's advanced age and supposedly declining health (without any further detail). Defendants have offered to make reasonable accommodations for Dr. Solomon including hosting the deposition at a location most convenient for him and dividing the deposition into multiple, shorter days; however, counsel has maintained that, nonetheless, Dr. Solomon will not appear voluntarily.

Given these disputes, in addition to the high volume of documents produced by the Parties within the last 60 days and the key productions that remain outstanding from UT, Defendants submit that good cause exists to extend the Scheduling Order deadlines by 60 days, so as to afford all Parties—particularly, Defendants—to resolve their disputes, review the full record of documents, and efficiently prepare for the 21 noticed depositions set to take place in the next month.

The undersigned certifies pursuant to Fed. R. Civ. P. 37(a)(1) that counsel for Defendants attempted in good faith to resolve these disputes in numerous letters and emails, as well as a telephonic meet and confer with counsel for UTRF and Dr. Solomon on September 8, 2022. These attempts were unsuccessful, and Defendants were required to file this motion seeking relief from the Court. For the reasons set forth in the accompanying Memorandum of Law, Defendants respectfully request that the Court grant this Motion.

Defendants further request that this Motion be set for a hearing to be scheduled at the Court's and parties' earliest convenience.

Dated: September 26, 2022

DLA PIPER LLP (US)

Christopher M. Strongosky (*pro hac vice*)
Michael D. Hynes (*pro hac vice*)
Anna K. Finger (*pro hac vice*)
Leeanne M. Mancari (*pro hac vice*)
1251 Avenue of the Americas, 27th Floor
New York, NY 10020
(212) 335-4500
christopher.strongosky@us.dlapiper.com
michael.hynes@us.dlapiper.com
anna.finger@us.dlapiper.com
leeanne.mancari@us.dlapiper.com

Attorneys for Defendant Caelum Biosciences, Inc.

VENABLE LLP

John D. Murnane (*pro hac vice*)
Zachary L. Garrett (*pro hac vice*)
1290 Avenue of the Americas, 20th Floor
New York, NY 10104
(212) 218-2527
jdmurnane@venable.com
zgarrett@venable.com

*Attorneys for Defendant The Trustees of
Columbia University in The City of New York*

PAINE TARWATER & BICKERS LLP

By: /s/ John W. Elder
John W. Elder (BPR #022775)
Lindsey M. Collins (BPR #033426)
Thomas H. Jarvis (BPR #036835)
900 South Gay Street, Suite 2200
Knoxville, TN 37902
(865) 525-0880
jwe@painetarwater.com
lmc@painetarwater.com
thj@painetarwater.com

HUNTER, SMITH & DAVIS LLP

/s/ Jimmie C. Miller

Jimmie C. Miller (TN Bar No. 009756)
Hunter Smith & Davis
1212 North Eastman Road
Kingsport, TN 37664
(423) 378-8852 Phone
(423) 378-8801 Fax
jmiller@hsdlaw.com

CERTIFICATE OF SERVICE

I hereby certify that on this 26th day of September, 2022, I have electronically filed the foregoing document with the Clerk of the Court using the CM/ECF system. Notice of this filing will be sent to all parties and counsel of record by operation of the Court's CM/ECF system. All other parties will be served by regular U.S. Mail. Parties may access this filing through the Court's electronic filing system.

/s/ John W. Elder